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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/976,411 | 10/12/2001 | Amy B. Reed | 03768/09633 | 1102 |

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EXAMINER

VO. HAI

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| ART UNIT | PAPER NUMBER |
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1771

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/976,411 | REED ET AL. | |
| | Examiner | Art Unit | |
| | Hai Vo | 1771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0726</u> . | 6) <input type="checkbox"/> Other: _____ |

1. The art rejections over Isaac et al (US 5,576,364) are withdrawn in view of the present amendment and arguments.
2. The art rejections over Brown Reed et al (US 6,156,677), Weber et al (US 5,191,734) and Bouchette (US 4,692,374) are maintained.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 21-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this case, support for the saturant being present at an add-on level of from about 20 to about 80 dry parts per 100 dry parts of fibers is not found in the Applicants' specification. The same token is applied to the range from about 20 to about 60 dry parts per 100 dry parts of fibers.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164

USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 21-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,743,522. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-15 of U.S. Patent No. 6,743,522 disclose a fibrous web being saturated with a composition comprising a blend of an acrylic latex polymer and ethylene acrylic acid. Claim 15 of U.S. Patent No. 6,743,522 discloses the saturant present in an amount of at least 25% by weight within the claimed range. Claim 15 of U.S. Patent No. 6,743,522 discloses the fibrous web having a Gurley porosity of less than about 120 seconds per 100cc within the claimed range. It appears that the fibrous web of substrate U.S. Patent No. 6,743,522 is suitable for use in medical packaging substrate and made from a material having a composition similar to the composition of the material used to form the medical packaging substrate of the present invention. Therefore, it is the examiner's position that the percent bacterial filtration efficiency would be inherently present. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. If the chemical composition of the claimed article of manufacture

recited in the claims is the same as the identical structure of the prior art, it is immaterial that the applicant recognized different advantages flowing therefrom than did the prior art. This is in line with *Titanium Metals Corp. of America v. Banner* (CAFC 1985) 227 USPQ 775.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 21-29 and 36-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown Reed et al (US 6,156,677). The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Brown Reed teaches a medical packaging material comprising a fibrous web being saturated with poly(vinylidene chloride)-acrylate (abstract and column 6, lines 1-6). Brown Reed discloses the saturant present in an amount of 50 to 150 percent by weight based on the dry weight of the fibers, overlapping with the claimed range. The medical packaging material has a Gurley porosity of about 30 to about 350 seconds per 100 cc of air per single sheet, within the claimed range. Brown Reed teaches the polymer emulsion comprising 100 percent on a dry weight basis of saturant (example 1, column 7, lines 23-25). Since Brown Reed is using the same polymer emulsion as Applicants, it is the examiner's position that the glass transition temperature would be inherently present. Since the medical packaging substrate of Brown Reed is made from a material having a composition similar to the composition of the material used to form the medical packaging substrate of the present invention. The medical packaging substrate of Brown Reed has the Gurley porosity within the claimed range. Therefore, it is the examiner's position that the percent bacterial filtration efficiency (BFE) would be inherently present. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. If the chemical composition of the claimed article of manufacture recited in the claims is the same as the identical structure of the prior art, it is immaterial that the applicant recognized different advantages flowing therefrom than did the prior art. This is in line with *Titanium Metals Corp. of America v. Banner* (CAFC 1985) 227 USPQ

775. Accordingly, it is the examiner's position that Brown Reed anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 21-41 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bouchette (US 4,692,374). Bouchette teaches an antimicrobial wet wiper comprising a fibrous web being saturated with an acrylate emulsion present in an amount of 5% to 30% by weight within the claimed range. Since Bouchette uses the same acrylate emulsion to form the saturant as Applicants (column 4, line 32), it is the examiner's position that the glass transition temperature of the acrylate emulsion would be inherently present. Like material has like property. This is in line with ***Ex parte Tummers et al.*** 137 USPQ 444 which holds that if the chemical composition of the claimed article of manufacture recited in the claims is the same as the identical structure of the prior art, it is immaterial that the applicant recognized different advantages flowing therefrom than did the prior art. Bouchette discloses the polymeric binder comprising an acrylate emulsion. There is no teaching or suggestion in the Bouchette reference that the polymeric binder

is comprised of additional materials in addition to the polymer emulsion. Likewise, the polymeric binder comprises 100% by weight of the polymer emulsion. Therefore, this reads on limitations of claim 28. Bouchette discloses the binder including a mixture of two polymer emulsions (column 4, lines 38-40). Bouchette teaches the binder comprising acrylate emulsion, butadiene-styrene emulsion and acrylonitrile-butadiene emulsion (column 4, lines 32-35). Therefore, it is not seen why the binder can be a combination of acrylate emulsion and an additional polymer emulsion selected from the group consisting of butadiene-styrene emulsion and acrylonitrile-butadiene emulsion. Again, Bouchett and Applicant both apparently use butadiene-styrene emulsion or acrylonitrile-butadiene emulsion as an additional polymer emulsion. Therefore, it is the examiner's position that the glass transition temperatures of these emulsions would be inherently present. Like material has like property. This is also in line with *Ex parte Tummers et al.* 137 USPQ 444. Bouchette does not specifically disclose the antimicrobial wet wiper having a Gurley Hill porosity and exhibiting a % BFE as recited in the claims. However, it appears that the antimicrobial wet wiper of Bouchette is made of the same materials with the similar composition as the medical packaging substrate of the present invention; i.e., paper based web impregnated with a binder present in an amount within the claimed range. The binder is a blend of acrylate emulsion and an additional polymer emulsion selected from the group consisting of butadiene-styrene emulsion and acrylonitrile-butadiene emulsion. Hence, it is the examiner's position that the

Gurley Hill porosity and the percent bacterial filtration efficiency (BFE) would be inherently present. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Note *In re Best* 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made under 35 USC 102. It is the examiner's position that Bouchette anticipates or strongly suggests the claimed subject matter.

11. Claims 21-41 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Weber et al (US 5,191,734). Weber teaches a biodegradable latex web material comprising a fibrous web being saturated with a latex binder which is a combination of polyacrylate and styrene butadiene polymer (column 4, lines 31-34, and table II). The latex binder is about 16 to 80 dry parts per 100 parts fibers by weight (column 5, line 29) within the claimed range. Since Weber uses the same polyarylate to form the saturant as Applicants (column 4, line 32), it is the examiner's position that the glass transition temperature of the polyacrylate would be inherently present. Like material has like property. This is in line with *Ex parte Tummers et al.* 137 USPQ 444 which holds that if the chemical composition of the claimed article of manufacture recited in the claims is the same as the identical structure of the prior art, it is immaterial that the applicant recognized different advantages flowing therefrom than did the prior art. Weber discloses the latex binder includes only synthetic latexes (column 4, lines 13-15). Likewise, the latex binder

comprises 100% by weight of the polymer emulsions. Therefore, this reads on limitations of claim 28. Weber discloses the binder including a mixture of two synthetic latexes (table II) such as polyacrylate and butadiene-styrene polymer. Again, Weber and Applicants both apparently use butadiene-styrene emulsion as an additional polymer emulsion. Therefore, it is the examiner's position that the glass transition temperature of the additional emulsion would be inherently present. Like material has like property. This is also in line with *Ex parte Tummers et al.* 137 USPQ 444. Weber does not specifically disclose the biodegradable latex web material having a Gurley Hill porosity and exhibiting a % BFE as recited in the claims. However, it appears that the biodegradable latex web material of Weber is made of the same materials with the similar composition as the medical packaging substrate of the present invention; i.e., paper based web impregnated with a binder present in an amount within the claimed range. The binder is a blend of acrylate emulsion and butadiene-styrene emulsion. Hence, it is the examiner's position that the Gurley Hill porosity and the percent bacterial filtration efficiency (BFE) would be inherently present. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Note *In re Best* 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made under 35 USC 102. It is the examiner's position that Weber anticipates or strongly suggests the claimed subject matter.

Response to Arguments

12. The art rejections over Brown Reed et al have been maintained for the following reasons. The Affidavit of Karen H. Bean filed on 07/02/2003 demonstrates that the medical packaging disclosed in Brown Reed '677 had an average BFE of 92.45%. The affidavit of Jay R. Sommer filed on 02/23/2004 shows that the claimed %BFE represents a significant improvement over the %BFE found in the Brown Reed invention. Applicants are reminded that the anticipation issues cannot be overcome by the affidavits under 37 CFR 1.132. And again, the examiner maintains that it is immaterial that the claim recites a property of the composition claimed that is not disclosed in the prior art where the prior art composition is the same as that claimed. Accordingly, the art rejections over Brown Reed are thus sustained.
13. The art rejections over Bouchette or Webber have been maintained for the following reasons. Applicants argue that Bouchette describes material for use in an antimicrobial wet wiper while Weber describes a material for use in agricultural mulch and row covers, bags, outer covers for personal care products. Such products differ substantially from the medical packaging substrate of the present claims, which is specifically designed to allow for surgical instruments contained therein to become sterilized. The arguments are not found persuasive for patentability. It is noted that the intended use of the material does not differentiate the claimed medical packaging substrate from a prior art antimicrobial wet wiper or diapers satisfying the claimed structural limitations. **Ex**

parte Masham, 2 USPQ2d 1647 (1987). Product claims must be structurally distinguishable from the prior art. Claims directed to a product must be distinguished from the prior art in terms of structure rather than intended use.

Applicants argue that Bouchette does not disclose the commercially available latex binders having a glass transition temperature within the claimed range of less than about -20°C. However, Bouchette also teaches the binder comprising acrylate emulsion, butadiene-styrene emulsion and acrylonitrile-butadiene emulsion (column 4, lines 32-35). Bouchette and Applicants both apparently use polyacrylate, butadiene-styrene and acrylonitrile-butadiene emulsions as the latex binder. Therefore, it is the examiner's position that the glass transition temperature of these emulsions would be inherently present. Like material has like property. This is also in line with ***Ex parte Tummers et al.*** 137 USPQ 444. Applicants state that since the products of Bouchette and Weber are not the same as those of the present invention, the basis of the inherent %BFE does not necessarily flow from the teachings of the cited references. The examiner disagrees. Nothing in the inherency rejections discussed in paragraph no. 7 and 8 is based on what would result due to the optimization of conditions as argued by Applicants. The inherency rejection is based on what was necessarily present in the prior art. The antimicrobial wet wiper of Bouchette is made of the same materials with the similar composition as the medical packaging substrate of the present invention; i.e., paper based web impregnated with a binder present in an amount within the claimed range. The binder is a blend of acrylate emulsion

and an additional polymer emulsion selected from the group consisting of butadiene-styrene emulsion and acrylonitrile-butadiene emulsion. The biodegradable latex web material of Weber is made of the same materials with the similar composition as the medical packaging substrate of the present invention; i.e., paper based web impregnated with a binder present in an amount within the claimed range. The binder is a blend of acrylate emulsion and butadiene-styrene emulsion. Hence, it is the examiner's position that the Gurley Hill porosity and the percent BFE would be inherently present in both Bouchette and Weber inventions. Accordingly, the art rejections are thus sustained.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1771

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

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